

REMARKS

Claims 1-27 are currently pending in the present application. In the Office Action mailed March 10, 2004, claims 1-27 stand rejected. Claims 1, 10, 12 and 16 have been amended. Claims 9 and 18-27 have been canceled, without prejudice. Applicant reserves the right to resubmit these claims, or claims of similar scope, in a continuation application.

Claims 1-6, 11, 12, 18, 23, 26, and 27 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Pat. No. 6,067,988, issued to Mueller et al. ("Mueller"). For a reference to anticipate a claim under 35 USC §102 the reference must teach every element of the claimed invention. (see MPEP §2131).

Mueller is directed to an apparatus and method for creating drug-filled pockets within muscle tissue. The apparatus has an excising assembly with a dilator tip for penetrating and advancing through the surface and body of a muscle. The dilator tip may have a low level laser optical fiber emission to ease the passage of the excising assembly and provide thermal damage to stimulate angiogenesis.

Independent claims 1 and 12 of the present application, as amended, are directed to a medicament delivery system and include an energy source for providing energy to remove or displace tissue, a medicament source comprising a medicament deliverable to tissue, an energy transmitting member having an inlet and for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy, and a medicament delivery member. Mueller fails to disclose an energy transmitting member having an inlet end for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy. Rather, Mueller discloses a device having a tapered dilator tip which is insertable into tissue and useful in excising a portion thereof wherein the dilator tip may have a low level laser optical fiber emission. As such, Mueller fails to teach or suggest all the claim limitations of the medicament delivery system of the present application. The Applicant respectfully submits that claims 1 and 12 are patentable over the cited reference. For at least the same reasons, the Applicant respectfully submits

that claims 2-6 and 11, which depend from claim 1, are also patentable. Claims 18, 23, 26, and 27 have been canceled, without prejudice. Applicant reserves the right to resubmit these claims, or claims of similar scope, in a continuation application.

Claims 1-6, 9-12, 18, 23, 26, and 27 of the present application stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,925,012, issued to Murphy-Chutorian et al. ("Murphy-Chutorian").

Murphy-Chutorian is directed to a drug delivery apparatus for dispensing drugs into an opening, such as a TMR channel. The device includes a laser delivery means such as an optical fiber or fiber bundle.

Independent claims 1 and 12 of the present application, as amended, include an energy source for providing energy to remove or displace tissue, a medicament source comprising a medicament deliverable to tissue, and an energy transmitting member having an inlet and for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy. Murphy-Chutorian fails to disclose an energy transmitting member having an inlet end for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy. As such, Murphy-Chutorian fails to teach or suggest all the claim limitations of the medicament delivery system of the present application. The Applicant respectfully submits that claims 1 and 12 are patentable over the cited reference. For at least the same reasons, the Applicant respectfully submits that claims 2-6 and 10-11, which depend from claim 1, are also patentable. Claims 9, 18, 23, 26, and 27 have been canceled, without prejudice. Applicant reserves the right to resubmit these claims, or claims of similar scope, in a continuation application. In light of the cancellation of claim 9, claim 10 has been amended to depend directly from claim 1.

Claims 1, 7, 8, and 12-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mueller in combination with United States Patent Application Publication No. US 2001/0049497, naming Kalloo et al. as inventors ("Kalloo"). To establish a prima facie case of obviousness, three basic criteria must be met by the Examiner. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to

modify the references or to combine the references teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. (see MPEP §2143.03).

Kaloo is directed to methods and devices for diagnostic and therapeutic interventions in the peritoneal cavity and discloses an elongated hollow flexible tube having an interior passage sized to receive and allow a passage of an endoscope, the tube having an open distal end, first and second inflatable balloon structures defined adjacent to the distal end of the tube, and an inflation conduit extending respectively from the first and second balloon structures to receive inflation ports disposed adjacent to a proximal end of the tube for this selective independent inflation and deflation of the balloon structures.

Independent claims 1, 12, and 16 of the present application, as amended, include an energy source for providing energy to remove or displace tissue, a medicament source comprising a medicament deliverable to tissue, and an energy transmitting member having an inlet and for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy. Kaloo, like Mueller and Murphy-Chutorian, fails to disclose an energy transmitting member having an inlet end for coupling to the energy source and an outlet and comprising an angular reflector disposed at the distal portion for emitting energy. As such, the Applicant respectfully submits that Mueller, Murphy-Chutorian and Kaloo, either alone or in combination, fail to teach or suggest all the claim limitations recited in independent claims 1, 12, and 16 of the present application, and the claims dependent therefrom. For at least the same reasons, the Applicant respectfully submits that claims 7 and 8, which depend from claim 1, and claims 13-17, which depend from claim 12, are also patentable. As such, the Applicant respectfully submits that claim 1, 7, 8, and 12-17 are patentable over the cited prior art references. Claims 18-25 have been canceled, without prejudice. Applicant reserves the right to resubmit these claims, or claims of similar scope, in a continuation application.

In view of the foregoing, it is submitted that all pending claims are in condition for immediate allowance, and such action is respectfully requested. However, if for any reason direct communication with the Applicant's attorney would serve to advance prosecution of this case to finale, the Examiner is cordially urged to call the undersigned attorney at the below listed telephone number.

The Commissioner is authorized to charge any fee which may be required in connection with this Amendment to deposit account No. 50-1329.

Respectfully submitted,

June 10, 2004



Bruce M. Canter
Registration No. 34,792

STRADLING YOCCA CARLSON & RAUTH
660 Newport Center Drive, Suite 1600
Newport Beach, CA 92660
Telephone: (949) 725-4198
Facsimile: (949) 823-5198